REMARKS

In response to the Office Action dated September 21, 2004, Applicants respectfully request reconsideration based on the above claim amendments and the following remarks. Applicants respectfully submit that the claims as presented are in condition for allowance.

Claims 1-6 and 11-15 are presently pending in this application. Claims 1, 5, and 11 are amended. Claims 7-10 are canceled, without prejudice or disclaimer.

The Office Action rejected claims 1-15 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,480,749 to Lee, Jr. et al. ("Lee").

A terminal disclaimer is enclosed to obviate the double patenting rejection.

The Office Action rejected claims 1-15 under 35 U.S.C. § 102(e) as being anticipated by Lee.

Under 37 C.F.R. 1.104(c)(2), in rejecting claims for want of novelty, when a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified. In other words, the Examiner must provide a factual basis or *prima facie* case for his rejection. A *prima facie* case of anticipation under 35 U.S.C. § 102 requires the disclosure in a single prior art reference of each element of the claim under consideration.

Although the Examiner did not particularly point out where each of the claim elements are disclosed in Lee for the 102 rejection, Applicants have reviewed Lee and respectfully submit that Lee fails to disclose each and every claim element.

Claim 1 recites, *inter alia*, "if parity does not exist, then calculating a remedy to be paid". By contrast, Lee discloses providing a mere report and raw data files. (Lee, abstract, figure 4, elements 410 and 412). Calculating an appropriate monetary remedy is more useful than providing a passive report with statistics. Therefore, claim 1 is patentable over Lee, because Lee fails to disclose the claimed calculating a remedy to be paid.

Claims 2-4 depend from claim 1 and, thus, inherit at least the patentable subject matter in claim 1. Therefore, claims 2-4 are also patentable over Lee.

Claim 5 recites, *inter alia*, "if parity does not exist, then calculating a remedy to be paid". For the same reasons given with respect to claim 1, claim 5 is patentable over Lee.

Claim 6 recites, *inter alia*, "calculating a balancing critical value that balances the parity probability and the favoritism probability". Although the Examiner did not particularly point out where the subject matter of claim 6 was disclosed in Lee, Applicants have reviewed Lee and respectfully submit that Lee fails to disclose any calculating a balancing critical value, fails to disclose any parity probability, and fails to disclose any favoritism probability. Therefore, for at least these reasons, claim 6 is patentable over Lee.

Claim 11 recites, *inter alia*, "if parity does not exist, then calculating a remedy to be paid". For the same reasons given with respect to claims 1 and 6, claim 11 is patentable over Lee.

Claim 12 recites, *inter alia*, "wherein calculating a remedy comprises: calculating a remedy for a selected CLEC." Claim 13 recites, *inter alia*, "wherein calculating a remedy comprises: calculating a remedy for all CLECs within a state." Claim 14 recites, *inter alia*, "wherein calculating a remedy comprises: using a fee schedule to calculate the remedy." Claim 15 recites, *inter alia*, "wherein calculating a remedy comprises: determining whether a previous remedy was calculated for a previous month; and if a previous remedy was calculated for a previous month, then adjusting the remedy". Although the Examiner did not point out with particularity where in Lee the subject matter of claims 12-15 was disclosed, Applicants have reviewed Lee and are unable to find the subject matter of claims 12-15. For at least the reasons given above, claims 12-15 are patentable over Lee.

The Office Action rejected claims 1-6 and 11 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,526,025 to Pack ("Pack").

A *prima facie* case of anticipation under 35 U.S.C. § 102 requires a single prior art reference to disclose each element of the claim under consideration.

Claim 1 recites, *inter alia*, "if parity does not exist, then calculating a remedy to be paid". The Examiner wrongly equated this element with a portion of Pack about investigating network problems and providing a corrective action, such as increasing network capacity. (Pack, col. 7, lines 1-25). This is not the same type of remedy, because Pack's remedy is concerned with addressing network problems, unlike the claimed monetary remedy. Therefore, claim 1 is patentable over Pack, because the Examiner did not establish a *prima facie* case of anticipation.

Claims 2-4 depend from claim 1 and, thus, inherit at least the patentable subject matter in claim 1. Therefore, claims 2-4 are also patentable over Pack.

Claim 5 recites, *inter alia*, "if parity does not exist, then calculating a remedy to be paid". For the same reasons given with respect to claim 1, claim 5 is patentable over Pack.

Claim 6 recites, *inter alia*, "calculating a balancing critical value that balances the parity probability and the favoritism probability". The Examiner wrongly cited Pack, cols. 6-8 and 10-12, as teaching claim 6. After careful review, Applicant was unable to find any such balancing critical value being calculated. Rather than do any balancing, Pack has a variance cutoff and does investigation, after a parity test. (Pack, abstract, col. 6 line 37 to col. 7 line 25). Therefore, claim 6 is patentable over Pack.

Claim 11 recites, *inter alia*, "if parity does not exist, then calculating a remedy to be paid". For the same reasons given with respect to claim 1, claim 11 is patentable over Pack.

The Office Action rejected claims 7-10 and 12-14 under 35 U.S.C. § 103(a) as being unpatentable over Pack in view of U.S. Patent Pub. No. 2003/0202638 A1 for Eringis et al. ("Eringis").

Claims 7-10 are canceled.

The Examiner has the burden of establishing a *prima facie* case of obviousness. Under 37 C.F.R. 1.104(c)(2), when a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

To establish a *prima facie* case of obviousness, the references must teach or suggest all the claim elements as arranged in the claim.

Claim 12 recites, *inter alia*, "wherein calculating a remedy comprises: calculating a remedy for a selected CLEC." Although the Examiner did not point out with particularity where in Pack or Eringis this claim was taught or suggested, Applicants have reviewed Pack and Eringis and are unable to find the subject matter of claim 12. For example, Pack discloses investigating network problems and providing a corrective action, such as increasing network capacity. (Pack, col. 7, lines 1-25). As stated above, this is not the same type of remedy, because Pack's remedy is concerned with addressing network problems, unlike the claimed monetary remedy. Thus, Pack teaches away from a monetary remedy. Eringis discloses providing a summary of statistics and test results, suggests fixing physical components, leaves it to someone else reviewing the report to decide what to do, provides all sorts of report data, and vaguely suggests "taking action"; however, none of these include calculating any monetary remedy as in the claimed invention. (Eringis, page 7, para. [0058];

page 8, para. [0067], page 9, para. [0077], page 11, para. [0094], page 23, paras. 0133] and [0134], page 35, para. [0180]). Indeed, providing voluminous reports, as in Pack, seems to teach away from the claimed calculation of a monetary remedy based on comparing performance measurements. Furthermore, calculating an appropriate monetary remedy is more useful than providing a passive report with statistics. Therefore, claim 12 is patentable over Pack and Eringis, because the Examiner did not establish a *prima facie* case of obviousness.

Claim 13 recites, *inter alia*, "wherein calculating a remedy comprises: calculating a remedy for all CLECs within a state." Claim 14 recites, *inter alia*, "wherein calculating a remedy comprises: using a fee schedule to calculate the remedy." For the same reasons given with respect to claim 12, claims 13 and 14 are also patentable over Pack and Eringis.

The Office Action rejected claim 15 under 35 U.S.C. § 103(a) as being unpatentable over Pack in view of U.S. Patent No. 6,011,838 to Cox ("Cox").

Claim 15 recites, *inter alia*, "wherein calculating a remedy comprises: determining whether a previous remedy was calculated for a previous month; and if a previous remedy was calculated for a previous month, then adjusting the remedy". Although the Examiner did not point to any particular section of Cox, Applicants reviewed Cox and did not find the subject matter of claim 15. Cox is generally directed to a process and system for dynamically and automatically measuring traffic across a communication network in order to ensure efficient allocation of network resources. (Cox, col. 1, lines 5-8). This has nothing to do with calculating any remedy. Cox discloses an evaluation of traffic data in order to engineer network elements for optimal traffic flow. (Cox, abstract). For the reasons given above with respect to Pack and because Cox also lacks the subject matter of claim 15, claim 15 is patentable over Pack and Cox. In addition, claim 15 is patentable over Pack and Cox because the Examiner failed to establish a *prima facie* case of obviousness.

For at least the reasons advanced above, it is respectfully submitted that the application is in condition for allowance. Accordingly, reconsideration and allowance of the claims are respectfully requested. The Examiner is cordially requested to telephone, if the Examiner believes that it would be advantageous to the disposition of this case.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment, which may be required for this amendment, to Deposit Account No. 06-1130. In the event that an extension of time is required, or may be required in addition to that requested

in any petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 06-1130.

Respectfully submitted,

By: Lea A. Nicholson

Lea A. Nicholson
Registration No. 48,346
CANTOR COLBURN LLP
55 Griffin Road South
Bloomfield, CT 06002
Telephone (860) 286-2929
Facsimile (860) 286-0115
Customer No. 36192